



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/892,721	06/27/2001	Shinichiro Mori	FUJS 18.776	4808

26304 7590 09/26/2003

KATTEN MUCHIN ZAVIS ROSENMAN  
575 MADISON AVENUE  
NEW YORK, NY 10022-2585

EXAMINER

GODDARD, BRIAN D

ART UNIT	PAPER NUMBER
----------	--------------

2171

DATE MAILED: 09/26/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/892,721

Applicant(s)

MORI ET AL.

Examiner

Brian Goddard

Art Unit

2171

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 27 November 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-46 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-46 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 June 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Priority***

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

### ***Specification***

2. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

The following title is suggested: SERVER, USER TERMINAL, INFORMATION PROVIDING SERVICE SYSTEM AND INFORMATION PROVIDING SERVICE METHOD FOR PROVIDING INFORMATION IN CONJUNCTION WITH A GEOGRAPHICAL MAPPING APPLICATION.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-46 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims are generally narrative and indefinite, failing to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors.

Referring only to claim 1 as exemplary of all the claims, the limitation "the three-dimensional space" in lines 9 to 10 lacks sufficient antecedent basis. Second, it is unclear whether "said display object attribute information" (lines 17-18) is transmitted from said user terminal in a mapping request (apparent from lines 15-16) OR whether it is retrieved as bubble data by the retrieving unit (apparent from lines 12-14), because to do both does not make sense and would raise issues under the first paragraph of 35 U.S.C. 112. This entire limitation is wordy and indefinite. Finally, it is unclear whether the limitation "said attribute information" in line 23 refers to the attribute information from line 7 or the display object attribute information from lines 14 and 18, or whether all three refer to the same thing. Thus, this limitation lacks sufficient antecedent basis and renders the claim even further indefinite.

In the interest of compact prosecution, the examiner interprets the claims to the best of his ability as provided below. Applicants' representative is requested to analyze all 46 claims in light of the example analysis of claim 1 above in order to place the claims in compliance with 35 U.S.C. 112, to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-3, 23 and 32 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,336,073 to Ihara et al.

Referring to claim 1, Ihara discloses a server in a system providing information to a user terminal being able to display a map as claimed. See Figures 1-16 and the corresponding portions of Ihara's specification for this disclosure. In particular, Ihara teaches "a server [310-370] in a system [Fig. 1] providing information to a user terminal [100] being able to display a map comprising:

a database [See column 16, line 50 – column 17, line 43] for holding a specific information document having index information [phone number, address, name, coordinates, etc.] composed of a plurality of elements out of information documents having attribute information [See Fig. 7] representing attributes of service information [POI information (See Fig. 7d)] to be provided as bubble data in which spatial range information [POS] in a three-dimensional space [See column 8, lines 16-18] is associated with retrieval information for obtaining said service information;

a retrieving unit [350-370] for retrieving specific bubble data [Detailed POI information] including coordinate information [POS] and display object attribute

information [See Figs. 7, 12 & 13] in said bubble data on the basis of a mapping request [Step S302, S505 or S509], transmitted from said user terminal [100], having said coordinate information [POS] on an object [POI] displayed on said map and said display object attribute information representing attributes of service information to be provided by said object; and

a notifying unit [340] for notifying said user terminal of a mapping response [See Figs. 13-14] having said spatial range information, said attribute information and said retrieval information included in said specific bubble data” as claimed.

Referring to claim 2, Ihara discloses the server as claimed. See Figures 13-14 and the corresponding portions of Ihara’s specification for this disclosure. In particular, Ihara teaches the server according to claim 1, as above, “wherein said notifying unit notifies of said mapping response having spatial range information including a similar bubble diameter [dispsize] having a diameter according to a scale of a map displayed on said user terminal and address information [See column 17, line 31 – column 18, line 45]” as claimed.

Referring to claim 3, Ihara discloses the server as claimed. See Figure 7 and the corresponding portion of Ihara’s specification for this disclosure. Ihara teaches the server according to claim 1, as above, “wherein said database correlates said bubble data [See Fig. 7d] with a unique number [POI-ID] by which contents of service information [POI information] of said bubble data can be identified, and holds said bubble data and said unique number” as claimed.

Referring to claim 23, Ihara discloses the user terminal in a system providing information to said user terminal being able to display a map as claimed. See Figures 1-2 and the corresponding portions of Ihara's specification, as well as the discussions regarding claims 1-3 above for the details of this disclosure. Ihara teaches "a user terminal [100]...comprising:

- a map information outputting unit [107]...;
- a display unit [108]...;
- a transmitting unit [109]...;
- a receiving unit [106]...;
- a mapping unit [104]...; and
- a mapping data holding unit [103]..." as claimed.

Referring to claim 32, Ihara discloses the information providing service method in a system providing information to a user terminal being able to display a map as claimed. See Figures 1-17 and the corresponding portions of Ihara's specification, as well as the discussions regarding claims 1 and 23 above for the details of this disclosure. Ihara teaches "an information providing service method [See Figs. 3-6]...comprising the steps of:

- a selecting step [S201, S301 or S505]...;
- a user terminal transmitting step [See transmitting unit in claim 23]...;
- a server transmitting step [See retrieving unit and notifying unit in claim 1]...; and
- a mapping step [See mapping unit in claim 23]..." as claimed.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 4-22, 24-31 and 33-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ihara in view of U.S. Patent No. 6,487,495 to Gale et al.

Referring to claim 4, Ihara discloses the server in a system providing information to a user terminal being able to display a map as claimed. See the discussion regarding claim 1 above for the details of this disclosure. Ihara's spatial range information explicitly includes latitude and longitude, as shown in Fig. 7c and discussed throughout the specification. Ihara also teaches that a third dimension is optionally included with the spatial range information as shown by reference element 370. However, Ihara is silent on the measure of the third dimension. Thus, Ihara does not explicitly teach that



the spatial range information includes altitude (as claimed), but does explicitly teach that a third dimension is used.

Gale discloses a system and method very similar to that of Ihara, in which latitude and longitude are used as anchor coordinates, with an optional use of altitude as a third dimension in order to provide the ability to specify elevation or a relative altitude (e.g. number of levels above or below street level) of a desired object. See column 5, lines 43-64 and column 9, lines 44-59 of Gale's specification for the details of this disclosure.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to implement Gale's use of altitude as the optional third coordinate in Ihara's system because this would enable the user to specify elevation (or number of levels above/below street level) of the desired object. One would have been motivated to modify Ihara as such because of Ihara's silence on the measure of the optional third dimension as discussed above.

Referring to claim 5, the system of Ihara in view of Gale as applied to claim 4 discloses the invention as claimed. See the discussion regarding claim 2 in light of the basis for claim 4 above.

Referring to claim 6, the system of Ihara in view of Gale as applied to claim 4 discloses the invention as claimed. See Figure 1 and the corresponding portion of Ihara's specification for this disclosure. Ihara's (as modified by Gale) retrieving unit retrieves said specific bubble data [Detailed POI information] in another database [350] connected to a network [400] on the basis of said mapping request as claimed.

Referring to claim 7, the system of Ihara in view of Gale as applied to claim 4 discloses the invention as claimed. See Figure 1 and the corresponding portion of Ihara's specification for this disclosure. Ihara's (as modified by Gale) server further comprises a Web information outputting unit [200] for holding user [subscriber] information [See column 7, lines 47-67] and an address generating unit [310 / 320] for generating an address [URL] at which said user information held in said Web information outputting unit is held as claimed.

Referring to claim 8, the system of Ihara in view of Gale as applied to claim 4 discloses the invention as claimed. See Figures 7d, 12 & 13 and the corresponding portions of Ihara's specification for this disclosure. Ihara's (as modified by Gale) database holds an animation element [image, audio, video, etc.] to be displayed on said user terminal [See Fig. 13] in document type definition [See Figures 7 & 12] information as claimed.

Referring to claims 9-11, the system of Ihara in view of Gale as applied to claim 4 discloses the invention as claimed. See Figures 7 & 12 and the corresponding portions of Ihara's specification for this disclosure. Ihara's (as modified by Gale) database holds an application program element [Conversion Program (See Fig. 12)] and a communication partner information element [See Figs. 7d & 12b], and classifies document type definition information [See Fig. 7] as claimed.

Referring to claim 12, the system of Ihara in view of Gale as applied to claim 4 discloses the invention as claimed. See the discussion regarding claim 3 in light of the basis for claim 4 above.

Referring to claim 13, the system of Ihara in view of Gale as applied to claim 12 discloses the invention as claimed. See Figures 6 & 13-17 and the corresponding portions of Ihara's specification for this disclosure. Ihara's (as modified by Gale) database "holds monitoring bubble data [Present POS Location] for detecting a moving object [vehicle, mobile phone, pda, etc.] and a bubble diameter [dispsize] of said monitoring bubble data based on position information on said moving object, and records a moving object element by which said moving object can be specified in a file held in said database [See Figs. 13-17]" as claimed.

Referring to claim 14, the system of Ihara in view of Gale as applied to claim 4 discloses the invention as claimed. See Figure 14 and the corresponding portion of Ihara's specification, and the discussion of claim 2 above, in light of the basis for claim 4.

Referring to claim 15, the system of Ihara in view of Gale as applied to claim 4 discloses the invention as claimed. See Figure 1 and the corresponding portion of Ihara's specification for this disclosure. Ihara's database holds at least either one of history information of address information caused by an access of said user terminal and identifier information [PPP address] by which said user terminal can be identified in a file as claimed.

Referring to claims 16-17, the system of Ihara in view of Gale as applied to claim 4 discloses the invention as claimed. See Figures 7 & 12 and the corresponding portions of Ihara's specification for this disclosure. Ihara's (as modified by Gale)

database holds data relating to a counter [<service> information] and data relating to an accessible time [<worktime> information] in a file as claimed.

Referring to claim 18, the system of Ihara in view of Gale as applied to claim 4 discloses the invention as claimed. See the discussion regarding claim 9 above for the details of this disclosure.

Referring to claim 19, the system of Ihara in view of Gale as applied to claim 4 above discloses the invention as claimed. See Figures 7 & 12 and the corresponding portions of Ihara's specification for this disclosure. Ihara's (as modified by Gale) database handles address information [See Fig. 7d & 12] based on said spatial range information [POS] as an electronic mail address [<address> information], and holds said spatial range information correspondingly to said electronic mail address as claimed.

Claim 20 is rejected on the same basis as claim 4. See the discussions regarding claims 1 and 4 above for the details of this disclosure.

Claims 21-22 are rejected on the same basis as claims 5 & 12 respectively, in light of the basis for claim 20. See the discussions regarding claims 1-5 and 12 above for the details of this disclosure.

Referring to claim 24, the system of Ihara in view of Gale as applied to claim 4 above discloses the invention as claimed. See the discussions regarding claims 4 and 23 above for the details of this disclosure.

Claim 25 is rejected on the same basis as claim 24. See the discussions regarding claims 1, 4 and 23 above for the details of this disclosure.

Claim 26 is rejected on the same basis as claim 5, in light of the basis for claim 25. See the discussions regarding claims 1-5 and 23 above for the details of this disclosure.

Referring to claims 27-28, the system of Ihara in view of Gale as applied to claim 25 above discloses the invention as claimed. See Figure 2 and the corresponding portion of Ihara's specification for this disclosure. Ihara's (as modified by Gale) user terminal [100] further comprises a detecting unit [102] for detecting position information...wherein said detecting unit comprises...a satellite information receiving unit being able to receive satellite information through the use of a global positioning system...as claimed.

Claim 29 is rejected on the same basis as claim 19, in light of the basis for claim 25. See the discussions regarding claims 1-4, 19 and 23 above for the details of this disclosure.

Referring to claims 30-31, the system of Ihara in view of Gale as applied to claim 4 above discloses the invention as claimed. See the discussions regarding claims 4 and 24 above for the details of this disclosure.

Referring to claims 33-34, the system of Ihara in view of Gale as applied to claim 4 above discloses the invention as claimed. See the discussions regarding claims 4 and 32 above for the details of this disclosure.

Claim 35 is rejected on the same basis as claim 5, in light of the basis for claim 33. See the discussions regarding claims 1-5 and 33 above for the details of this disclosure.

Claim 36 is rejected on the same basis as claims 16-17, in light of the basis for claim 35. See the discussions regarding claims 1-5, 16-17 and 33-35 above for the details of this disclosure.

Claim 37 is rejected on the same basis as claim 9, in light of the basis for claim 33. See the discussions regarding claims 1-4, 9 and 33 above for the details of this disclosure.

Claims 38-39 are rejected on the same basis as claims 16-17, in light of the basis for claim 33. See the discussions regarding claims 1-4, 16-17 and 33 above for the details of this disclosure.

Referring to claim 40, the system and method of Ihara in view of Gale as applied to claim 33 above discloses the invention as claimed. Neither Ihara nor Gale explicitly states that retrieval is performed on the basis of the number of accesses that the server can receive concurrently as claimed. However, the examiner takes Official notice that it was common knowledge in the art at the time of applicants' invention to perform accesses to a server (such as Ihara's) based on the number of accesses the server could receive concurrently. In other words, if a server was concurrently handling the maximum number of concurrent accesses when another process desired access to the server, the new process would have to wait for a concurrent process to finish in order to gain access to the server. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made that Ihara's server performed retrieval on the basis of the number of accesses that said server could receive concurrently,

because of the desire to keep from overloading the server with more accesses than it could handle concurrently.

Claims 41-42 are rejected on the same basis as claims 10 and 13, in light of the basis for claim 33. See the discussions regarding claims 1-4, 10, 13 and 33 above for the details of this disclosure.

Claim 43 is rejected on the same basis as claim 33. See the discussions regarding claims 32 and 33 above for the details of this disclosure.

Referring to claims 44-46, the system and method of Ihara in view of Gale as applied to claim 4 above discloses the invention as claimed. See the discussions regarding claims 4-19 and 33-42 above for the details of this disclosure.

### ***Conclusion***

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Patent No. 6,487,305 to Kambe et al. and U.S. Patent No. 6,263,343 to Hirono are both considered particularly pertinent to applicants' claimed invention.

The remaining prior art of record is considered pertinent to applicants' disclosure and/or portions of applicants' claimed invention.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian Goddard whose telephone number is 703-305-7821. The examiner can normally be reached on M-F, 9 AM - 5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic can be reached on 703-308-1436. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

bdg



SAFET METJAHIC  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2100